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EXAMINER

ELAHEE, MD S

ART UNIT

PAPER NUMBER

2697

DATE MAILED: 09/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/834,089

Applicant(s)

ISAACS ET AL.

Examiner

Md S Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 8, 9, 11, 13, 14 and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Pines et al. (U.S. Pub. No. 2003/0007625).

Regarding claim 1, Pines teaches receiving a message from a first caller, the message identifying at least one subscriber (page 2, paragraph 0025, page 12, paragraph 0148; 'caller' reads on the claim 'user' and 'subscriber' reads on the claim 'message recipient').

Pines further teaches providing the message to the at least one subscriber, wherein when the message is provided to the at least one subscriber, the first user's sound ID is played for the at least one subscriber upon delivery of the message to the at least one subscriber, the sound ID having been previously selected by the first caller for identifying the first caller to the at least one subscriber (page 2, paragraph 0025, page 12, paragraph 0148; 'subscriber' reads on the claim 'message recipient' and 'caller' reads on the claim 'user').

Regarding claim 2, Pines teaches that the message received from the first user is an instant messaging communication (page 2, paragraph 0025, page 3, paragraph 0047, page 12, paragraph 0148).

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Regarding claim 8, Pines teaches providing the message to the at least one subscriber comprises playing the first user's sound ID followed by the message, the message being a text instant message (page 2, paragraph 0025, page 12, paragraph 0148; 'subscriber' reads on the claim 'message recipient').

Regarding claim 9, Pines teaches receiving a plurality of call pre-announcement selections from a plurality of callers in the network, each caller selecting a unique call pre-announcement to identify themselves to the other callers in the network (page 2, paragraphs 0019, 0025, page 12, paragraph 0148; 'call pre-announcement' reads on the claim 'audible signature' and 'callers' reads on the claim 'users').

Pines further teaches distributing communications between the plurality of callers in the network, wherein each communication is accompanied by the unique call pre-announcement of the caller which initiated the communication so as to identify that caller to the one or more callers who are receiving the communication (page 2, paragraph 0025, page 12, paragraph 0148; 'callers' reads on the claim 'users' and 'call pre-announcement' reads on the claim 'audible signature').

Regarding claim 11, Pines teaches that the callers receiving the message is played the call pre-announcement of the caller which initiated the communication followed by the playing of the actual communication (page 2, paragraphs 0019, 0025, page 12, paragraph 0148; 'callers' reads on the claim 'users' and 'call pre-announcement' reads on the claim 'audible signature').

Regarding claim 13, Pines teaches providing a selection of call pre-announcements for selection by the plurality of callers (page 2, paragraphs 0019, 0025, page 12, paragraph 0148;

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'call pre-announcements' reads on the claim 'audible signatures' and 'callers' reads on the claim 'users').

Regarding claim 14, Pines teaches that two or more of the plurality of callers are prevented from selecting the same call pre-announcement (page 2, paragraphs 0019, 0025, page 12, paragraph 0148; 'callers' reads on the claim 'users' and 'call pre-announcement' reads on the claim 'audible signature').

Regarding claim 16, Pines teaches providing a selection facility for subscriber selections of call pre-announcements, the call pre-announcements uniquely identifying the selecting caller to other callers in the communications network (page 2, paragraphs 0019, 0025, page 12, paragraph 0148; 'subscriber' reads on the claim 'receiving user', 'call pre-announcements' reads on the claim 'audible sound identifiers' and 'caller' reads on the claim 'user').

Pines further teaches identifying the callers to one another in the communication network, wherein identifying the callers to one another comprises providing the users' selected call pre-announcements to one another in the course of communications between the callers such that each caller is identified to the other by the sound of their respective call pre-announcement (page 2, paragraph 0025, page 12, paragraph 0148; 'callers' reads on the claim 'users' and 'call pre-announcements' reads on the claim 'audible sound identifiers').

Regarding claim 17, Pines teaches that the selection facility comprises a plurality of call pre-announcements organized into categories (page 2, paragraphs 0019, 0020, 0025, page 12, paragraph 0148; 'call pre-announcements' reads on the claim 'audible sound identifiers').

Regarding claim 18, Pines teaches that callers are allowed to create their own call pre-announcements for inclusion in the selection facility (page 2, paragraphs 0019, 0025, page 12,

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paragraph 0148; 'callers' reads on the claim 'users' and 'call pre-announcements' reads on the claim 'audible sound identifiers').

Regarding claim 19, Pines teaches that the call pre-announcements are not re-played for caller inherently during repetitive communications between the callers (page 2, paragraphs 0019, 0025, page 12, paragraph 0148; 'call pre-announcements' reads on the claim 'audible sound identifiers' and 'caller' reads on the claim 'user').

Regarding claim 20, Pines teaches distributing the selected call pre-announcement corresponding to one caller to the other callers in the communications network (page 2, paragraphs 0019, 0025, page 12, paragraph 0148; 'call pre-announcement' reads on the claim 'audible sound identifier' and 'caller' reads on the claim 'user').

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pines et al. (U.S. Pub. No. 2003/0007625) and in view of Epler et al. (U.S. Patent No. 6,026,156).

Regarding claim 3, Pines teaches the message received from the first caller (page 2, paragraph 0025, page 12, paragraph 0148; 'caller' reads on the claim 'user').

However, Pines fails to teach "activity status message". Epler teaches Distinctive Ringing (col.5, lines 61-67, col.6, lines 1, 2; 'Distinctive Ringing' reads on the claim 'activity status

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message'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pines to allow activity status message as taught by Epler. The motivation for the modification is to have doing so in order to provide the contact information from where the incoming message being originated.

Regarding claim 4, Pines fails to teach "the message provided to the at least one message recipient is an activity alert sound". Epler teaches that the message provided to the at least one user is a Distinctive Ringing (col.5, lines 61-67, col.6, lines 1-21; 'user' reads on the claim 'message recipient' and 'Distinctive Ringing' reads on the claim 'activity alert sound'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pines to allow the message provided to the at least one message recipient is an activity alert sound as taught by Epler. The motivation for the modification is to have doing so in order to provide the contact information from where the incoming message being originated.

Regarding claim 5, Pines teaches that the pre-announcement alerts the at least one subscriber that the first caller has become active on at least one client device (page 2, paragraph 0025, page 12, paragraph 0148; 'pre-announcement' reads on the claim 'activity alert sound', 'subscriber' reads on the claim 'message recipient' and 'caller' reads on the claim 'user').

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pines et al. (U.S. Pub. No. 2003/0007625) and in view of Walker et al. (U.S. Patent No. 6,397,184).

Regarding claim 6, Pines fails to teach "the sound ID is a snippet of notes". Walker teaches that the identification is an audio snippet (abstract; col.3, lines 34-47; 'identification' reads on the claim 'sound ID' and 'audio snippet' reads on the claim 'snippet of notes'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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modify Pines to allow the sound ID as a snippet of notes as taught by Walker. The motivation for the modification is to have doing so in order to provide the identification display.

6. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pines et al. (U.S. Pub. No. 2003/0007625) and in view of Meffert et al. (U.S. Pub. No. 2002/0059144).

Regarding claim 7, Pines fails to teach “the sound ID is at least a portion of a popular song”. Meffert teaches that the sound ID is at least a portion of a popular song (page 11, paragraph 0106). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pines to allow the sound ID being at least a portion of a popular song as taught by Meffert. The motivation for the modification is to have doing so in order to provide the attractive sound.

Regarding claim 10, Pines teaches that the unique call pre-announcement is a portion of a song recognized by the subscribers as identifying the caller (page 2, paragraph 0025, page 12, paragraph 0148; ‘call pre-announcement’ reads on the claim ‘audible signature’, ‘subscribers’ reads on the claim ‘receiving users’ and ‘caller’ reads on the claim ‘initiating user’).

However, Pines fails to teach “the unique audible signature is a portion of a song”. Meffert teaches that the unique audible signature is at least a portion of a popular song (page 11, paragraph 0106). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pines to allow the unique audible signature being at least a portion of a popular song as taught by Meffert. The motivation for the modification is to have doing so in order to provide the attractive sound.

7. Claims 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pines et al. (U.S. Pub. No. 2003/0007625) and in view of Reformato et al. (U.S. Patent No. 6,229,880).



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Regarding claim 12, Pines fails to teach "activity status update". Reformato teaches status information update (col.14, lines 17-29; 'status information update' reads on the claim 'activity status update'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pines to allow activity status update as taught by Reformato. The motivation for the modification is to have doing so in order to provide the change in the status information.

Regarding claim 15, Pines fails to teach "the audible signature is preceded by an activity signal, the activity signal based upon the activity level of the initiating user". Reformato teaches that the identification is preceded by a status information, the status information based upon the activity level of the subscriber (col.14, lines 17-29; 'identification' reads on the claim 'audible signature', 'status information' reads on the claim 'activity signal' and 'subscriber' reads on the claim 'initiating user'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pines to allow the audible signature being preceded by an activity signal, the activity signal based upon the activity level of the initiating user as taught by Reformato. The motivation for the modification is to have doing so in order to provide the status information of the message.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alam Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on (703)305-4717. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

*M. E.*

MD SHAFIUL ALAM ELAHEE

September 7, 2003

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', written over a diagonal line that extends from the bottom right of the signature block.